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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,392	03/29/2001	Nathaniel P. Langford	54493USA3C	3598

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 11/27/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,392

Applicant(s)

LANGFORD, NATHANIEL P.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) 24-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 24-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 24-37, drawn to a wall repair compound, classified in class 106, subclass 802.
 - II. Claims 38-44, drawn to a paste-like mixture, classified in class 106, subclass 822.
 - III. Claims 46-49, drawn to drywall joint compound, classified in class 106, subclass 802.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and they have different functions and/or different effects.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the two different genii in the invention of Group I.

For the first genus (A), the species are:

- a. Wherein the dust reducing additive comprises a wax. (Claim 28)
- b. Wherein the dust reducing additive comprises a mixture of two oils.
(Claims 29 and 30)
- c. Wherein the dust reducing additive comprises a saturated oil. (Claim 32)
- d. Wherein the dust reducing additive comprises a solvent. (Claim 33)

For the second genus (B), the species are:

- a. Wherein the filler is selected from the group of claim 35.
- b. Wherein the filler is calcium sulfate hemihydrate. (Claim 33)

If Group I is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species of each of the two different genii for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 45 is generic to the three inventions and claim 24 is generic in Group I.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with David Patchett on 11/20/02, a provisional election was made with traverse to prosecute the invention of Group III, claims 45-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 45 is rejected under 35 U.S.C. 102(b) as anticipated by Cole (USPN 5,595,782), Struss et al. (USPN 4,686,253), Williams (USPN 4,454,267), Wakabayashi et al. (JP 07206504), Kono et al. (JP 06158047), or Kondrats (USPN 5,439,608).

In col. 4, lines 17-21 and col. 5, lines 16-30, Cole teaches a dust reducing additive for dust generating materials. Said dust reducing additive comprising a surfactant, paraffinic, naphthenic or aromatic oils.

In col. 1, lines 7-9, col. 3 lines 1-50, and Table I, Williams teaches a joint compound comprising wetting agents (surfactant compounds).

In col. 1, lines 7-9, col. 3 lines 14-67, and col. 4, lines 5-26, Struss et al. teach a joint compound comprising wetting agents.

Each of Wakabayashi et al. and Kono et al. teach hardenable compositions prepared by mixing material such as cement and 1-5% of a dust reducing additive comprising liquid paraffin. (See abstracts)

In col. 2, lines 43-67, col. 3, lines 47-60 and col. 5, lines 44-52, Kondrats teaches a dust reducing concentrate usable with materials prone to dust (such as cement materials). Said concentrate is taught to comprise

- a) 5 to 20% of a surfactant and
- b) 10 to 20% of mineral oils, vegetable oils, or a mixture thereof.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

9. Claims 45 and 46 rejected under 35 U.S.C. 102(b) as being anticipated by Kaplan (USPN 5,494,947)

In col. 2, lines 35-38, col. 3, lines 13-25, col. 5, lines 32-64 and col. 6, lines 31-39, Kaplan teaches a joint compound comprising a calcium carbonate filler, an acrylate binder, and from 0.10 to 0.20% of a surfactant.

Since the compound of Kaplan is "useful", it is deemed to contain enough water to be "useful".

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

10. Claims 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (USPN 5,653,797) or Trmata (CA 1,117,989).

In col. 1, lines 7-11, col. 2, lines 15-33, col. 3, lines 55-64, col. 7, lines 12-16, col. 8, Table I and II, and col. 9, lines 35-44, Patel teaches a joint compound comprising:

- a) 1 to 100% of a filler,
- b) 1 to 4 % of latex binder material,
- c) 20 to 37% of water, and
- d) 0.1 to 50% of wetting agents.

In page 2, lines 9-16 and page 3, lines 25-30, Trmata teaches a stucco composition for repairing wall material, comprising:

- a) 35 to 55% of calcium carbonate,
- b) 15 to 30 % of binder material,
- c) 15 to 30% of water, and
- d) 3 to 30% of linseed oil.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

11. Claim 49 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kaplan, Patel or Trmata.

While Kaplan, Patel or Trmata do not expressly teach the disclosed sanding properties of the claimed composition, it is still reasonable that the compositions Kaplan, Patel or Trmata would possess the presently claimed properties since the compositions of Kaplan, Patel or Trmata contain the same components as and are essentially the same as the present claimed composition. The USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort, and, in any event, an otherwise old composition is not patentable regardless of

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any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


KCE
November 25, 2002